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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,752	05/22/2001	Peter J. Kuzma	9905-20	9127
7590	05/31/2005		EXAMINER LEE, BENJAMIN C	
Eric K. Satermo Registered Patent Agent P.O. Box 19099 Irvine, CA 92623-9099			ART UNIT 2632	PAPER NUMBER

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/863,752

Applicant(s)

KUZMA ET AL.

Examiner

Benjamin C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/21/05 has been entered.

### ***Claim Status***

2. **Claims 1-19** are pending.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 10-11, 16-17 and 19-20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In claim 10, line 3; claim 16, line 6; and claim 17, line 1, "the contacts of the file" lacks antecedent basis. Furthermore, it is unclear how "contacts of the file" is different from contacts of the circuit whereby the circuit and its contacts are placed in/on the file.

2) Claim 11 is rejected due to dependency of rejected claim 11 that incorporated the same rejected matter.

3) Claim 17, line 1, "the recess" lacks antecedent basis.

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4) Claims 19-20 are duplicates of claims 14-15.

***Claim Rejections - 35 USC § 103***

5. **Claims 1 and 5-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. (US pat. #6,045,652) in view of Stanfield et al. (US pat. #5,751,221).

1) In considering claim 1:

Tuttle et al. teaches a radio-frequency identification (RFID) system for article location and tracking (col. 1, line 45 to col. 2, line 22 and col. 3, lines 57-58) comprising: a transponder assembly including: a substrate (68 of Fig. 5A, 78 of Figs. 6E) having a pair of sides; an antenna (col. 8, lines 60-64 and Figs. 5A and 6E) disposed on one of the sides of the substrate; a circuit (64) coupled to the antenna and having an identifier code (inherent from “RFID” and location/tracking uses); and an adhesive layer (80) disposed on the other side of the substrate; the transponder assembly being attached to an intended use application surface by the adhesive (col. 9, lines 7-9);

Stanfield et al. teaches the known application of RFID devices 120 of unspecified assembly to files 70 by attaching the RFID device to one of the two covers of the file for identification and location tracking of the file according to Fig. 15 and Abstract.

In view of the teachings by Tuttle et al. and Stanfield et al., it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement the file identification and location tracking system such as taught by Stanfield et al. using a known specific RFID assembly such as taught by Tuttle et al.

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2) Regarding claims 5-6, Tuttle et al. and Stanfield et al. render all of the claimed subject matter obvious as in claim 1, except:

--specifying the claimed top coat (claim 5) or lamination sheet (claim 6) applied over the transponder assembly or antenna and the circuit.

However, Tuttle et al. discloses that a polymer insulating layer 114 is formed over the transponder assembly including its antenna and circuit, the layer 114 provides a hermetic seal to the assembly by application to layer 100 using either heat or adhesive sealing (col. 9, lines 56-63), and elsewhere discloses the known application of coating (e.g. col. 9, lines 10-11; col. 12, lines 46 and 56-58) and lamination (e.g. col. 9, line 5; col. 10, line 62; col. 11, lines 8, 52 and 58) as processes for providing a top layer or sheet onto a surface. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention that such layer application in Tuttle et al. and Stanfield et al. can be implemented using a known lamination sheet application or a known top coat application to achieve similar objectives of the layer application.

3) Regarding claims 7-8, Tuttle et al. and Stanfield et al. render all of the claimed subject matter obvious as in claim 1, including:

--the claimed wherein the circuit is: (claim 7) a passive circuit (col. 3, lines 43-50 of Tuttle et al.) or (claim 8) an active circuit (Fig. 1A of Tuttle et al. using battery power).

6. **Claim 2, 9-10 and 16-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. in view of Stanfield et al. and Brady et al. (US pat. #6,201,474).

1) Regarding claims 2 and 9, Tuttle et al. and Stanfield et al. render all of the claimed subject matter as in the consideration of claim 1, except:

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--the claimed embedding of the antenna on one of the covers that include a channel for accommodating the antenna (claim 2), and a recess configured to receive the circuit (claim 9).

In the same RFID article identification and location tracking (col. 3, lines 3 and 9-10) art, Brady et al. teaches the known application of the RFID tag to the article by embedding the RFID tag including its antenna to the article whereby the article includes a recess/channel for accommodating the RFID tag including its antenna and circuit (col. 6, line 61 to col. 7, line 5 and col. 7, lines 55-58).

In view of the teachings by Tuttle et al., Stanfield et al. and Brady et al., it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to embed, using accommodating longitudinally shaped recess which can be interpreted as a channel as well as a recess as taught by Brady et al., the RFID tag of Tuttle et al. and Stanfield et al. to the file cover as a way to apply the RFID tag to the file cover while minimizing the alteration to the outer appearance of the file cover based on user preference.

2) Regarding claim 10, Tuttle et al., Stanfield et al. and Brady et al. render all of the claimed subject matter as in claim 2, including:

--the claimed wherein the circuit includes a pair of contacts for coupling with the contacts of the file (here interpreted as contacts of the circuit which are placed in/on the file: 7-10 in Fig. 1A of Tuttle et al.)

3) Regarding claim 16, Tuttle et al., Stanfield et al. and Brady et al. render all of the claimed subject matter obvious as in the consideration of claims 2 and 10.

7. **Claims 3 and 12-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. in view of Stanfield et al. and Isaacman et al. (US pat. #5,936,527).

1) In considering claim 3, Tuttle et al. and Stanfield et al. made obvious all of the claimed subject matter as in the consideration of claim 1, and:

Stanfield et al. teaches use of a reader (27 in Fig. 2 and according to col. 6, lines 15-24 in combination with Fig. 15) in communication with a plurality of antenna for receiving a transponder response, each antenna being disposed at or near one of the locations of a site for tracking of objects (the RFID embodiment of Fig. 15 when used with a large system of Fig. 2 requiring plural antennas), and an administrator (20 in Fig. 15 of Stanfield et al.) in communication with the reader for receiving information from the reader indicative of the location of the file associated with the transponder assembly transmitting the signal indicative of the identifier code (Abstract);

while Isaacman et al. further teaches the use of a plurality of antenna arrays for generating an energizing field for providing transponder response to the reader and administrator for identification and location tracking (Figs. 3-4).

In view of the teachings by Tuttle et al., Stanfield et al. and Isaacman et al., it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that a file tracking system such as taught by Tuttle et al. and Stanfield et al. when using passive type (col. 3, lines 44-50 of Tuttle et al.) transponders to track objects over a large area can make use of the energizing field generating and response detecting antenna arrays such as taught by Isaacman et al. for more effective implementation of the intended tracking function by virtue of better coverage provided by the antenna arrays over the large area.

2) Regarding claims 12-13, Tuttle et al., Stanfield et al. and Isaacman et al. render all of the claimed subject matter obvious as in claim 3, plus the consideration of claims 5-6.

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8. **Claims 4, 14-15 and 18-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. in view of Scott et al. (US pat. #6,121,880)

1) In considering claim 4:

Tuttle et al. teaches a transponder label assembly including: a substrate (68 of Fig. 5A, 78 of Figs. 6E) having a pair of sides; an antenna (col. 8, lines 60-64 and Figs. 5A and 6E) disposed on one of the sides of the substrate; transponder circuit (64) coupled to the antenna and having an identifier code (inherent from “RFID” and location/tracking uses); and an adhesive layer (80) disposed on the other side of the substrate;

except specifying the claimed backing sheet releasably attached to the adhesive layer of the transponder assembly.

Scott et al. teaches a similar transponder having adhesive layer 14 and using release liner 12 to cover/protect it before usage (Fig. 2). In view of the teachings by Tuttle et al. and Scott et al., it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to use a release backing sheet such as taught by Scott et al. to attach to the adhesive layer of the transponder label of Tuttle et al. so as to prevent destroying of the adhesives before it is actually applied to a bonding/labeling surface.

2) Regarding claims 14-15 (and corresponding duplicate claims 19-20), Tuttle et al. and Scott et al. render all of the claimed subject matter obvious as in claim 4, plus the consideration of claims 7-8, respectively.

3) Regarding claim 18, Tuttle et al. and Scott et al. render all of the claimed subject matter obvious as in the consideration of claim 4.



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9. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. in view of Scott et al., Stanfield et al. and Brady et al.

1) Regarding claim 17, Tuttle et al. and Scott et al. render all of the claimed subject matter obvious as in claim 14, plus the consideration of claim 9 further in view of Stanfield et al. and Brady et al.

### ***Response to Arguments***

10. Applicant's arguments filed 3/21/05 have been fully considered but they are not persuasive. Furthermore, new grounds of rejection using new primary reference (Tuttle et al.) have been applied that moots applicant's arguments.

1) It is noted that the original claims 1-4 claims "comprising", the limitation that follows in the claims do not preclude additional intervening features. For example, the transponder can be totally encapsulated on all sides, then adds an adhesive layer on the exterior, then either applied to an external surface or embedded to an article, and still reads on the claimed invention. Direct application of adhesive to the substrate was never claimed. However, examiner has used better reference of Tuttle et al. to obviate such argument even if applicant were to amend the claims to differentiate them from the previously used Moskowitz et al. reference, such as new claim 18.

2) Remaining issues are moot in view of the new grounds of rejection using new combination/reference of Tuttle et al. See above rejection for detail.

### ***Conclusion***

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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US 5,894,268; US 5,260,690

--Similar known attachment of tag/transponder using recess.


2) US 4,063,229

--A known use of embedding a tag/transponder in paper article.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin C. Lee whose telephone number is (571) 272-2963. The examiner can normally be reached on Mon -Fri 11:00Am-7:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Benjamin C. Lee  
Primary Examiner  
Art Unit 2632

B.L.